

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of December 31, 2003.

All of the Examiner's objections and rejections are traversed.

Reexamination and reconsideration are respectfully requested.

The Office Action

Claims 1-20 were presented for examination.

Claims 1-20 are now in the application.

Claims 1-5, 9-18, and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by Motamed et al. (U.S. Patent 6,549,300).

Claims 6 and 19 stand rejected under section 103(a) as being unpatentable over Motamed et al. (U.S. Patent 6,549,300) in view of Tonomura et al. (U.S. Patent 6,571,054).

The Interview with the Examiner

On March 9, 2004, Applicants held a telephone interview with the Examiner. Applicants gratefully acknowledge the opportunity to discuss the application and cited references.

At the interview, the Applicants discussed with the Examiner that the Motamed claims a filing date from a provisional application which (1) does not comply with the first paragraph of section 112 and (2) does not disclose every limitation of the claims of the present application. As a result of the interview, it is Applicants understanding that these considerations are sufficient to overcome Motamed.

The Motamed Reference

Motamed, filed February 22, 2001, claims a filing date of the provisional application 60/184,791 ("Motamed provisional") filed on February 24, 2000. For the purposes of applicability of the prior art, the effective filing date of the U.S.

application is the effective filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. §112 by the provisional application. MPEP §706.02. Accordingly, Motamed is applicable as the prior to reject the present application under section 102 only for the claims fully supported under section 112, first paragraph by the provisional application 60/184,791. (The provisional application 60/184,791 was obtained through the Faxpat services on March 1, 2004 and is attached for the Examiner's convenience.) Applicants respectfully submit the Motamed provisional does not comply with the section 112, first paragraph, to support at least independent claims 1, 15, 17, and 20 of the present application. Motamed provisional complies with neither of: (1) a written description of the present invention; (2) the enablement; or (3) the best mode requirement. As such, Motamed provisional does not support claims of the present application. It is respectfully submitted that claims 1-20 distinguish patentably over Motamed and, therefore, are allowable.

In addition, the Applicants note that to sustain the 102 rejection, Motamed is potentially applicable only to the extent to which the Motamed provisional application teaches every element of the claims as discussed in a greater detail below.

Claims 1-14 Distinguish Over Motamed

Claim 1 calls for among other limitations: a user interface comprising a tab data entry frame facilitating entry of tab data, including a total number of said tabbed pages in said document and a number of unique tab positions to format said tabbed pages; and a page preview frame showing a layout of the unique tab positions for formatted tabbed pages and said tab content entered for each associated tab. Motamed provisional discloses InsertTabs setup window, Tab Media Name edit window, Tab Text Offset window, Insert Tabs window, Tab Text edit window and InsertTabs Assistant window. A user programs the automatic insertion, printing and collation of tab media into a job. (Page 1, line 2). Total number of tabs is selected from a pull down menu, e.g. from a prespecified

number 1 through 8. (Page 1, line 13). Motamed provisional does not disclose or suggest:

1. a user interface having a tab data entry frame and a page preview frame, wherein both frames are displayed in the same window;
2. entry of a total number of tabs;
3. entry of a number of unique tab positions; or
4. contemporaneous display of a layout of the unique tab positions for formatted tabbed pages and the tab content entered for each associated tab on the tab preview frame.

It is therefore respectfully submitted that **claim 1 and dependent claims 2-14** distinguish patentably and unobviously over Motamed provisional.

Claims 15-16 Distinguish Over Motamed

Claim 15 calls for among other limitations: an output device for processing said document including said tabbed pages and said partitioned sections. Motamed provisional discloses "document print." (Page 2, lines 20-22). Motamed provisional does not disclose or suggest an output device for *processing* tabbed pages and partitioned pages. It is therefore respectfully submitted that claim 15 and dependent claim 16 distinguish patentably and unobviously over Motamed provisional.

Claims 17-19 Distinguish Over Motamed

Claim 17 calls for among other limitations: entering tab modulus data including a number of unique tab positions. Motamed provisional discloses selecting number of total tab positions, 1 through 8, from a pull down menu. (Page 1, line 13). Motamed does not disclose or suggest entering the number of unique positions as disclosed in claim 17. It is therefore respectfully submitted that claim 17 and dependent claims 18-19 distinguish patentably and unobviously over Motamed provisional.

Claim 20 Distinguishes Over Motamed

Claim 20 calls for among other limitations: a storage medium for use in an electronic device, entering tab modulus including a total number of tabbed pages in said document; formatting said document; and transmitting said document to a printing device. Motamed provisional discloses selecting number of total tab positions, 1 through 8, from a pull down menu. (Page 1, line 13). Motamed provisional also discloses "document print." (Page 2, lines 20-22). Motamed provisional does not disclose or suggest a method for processing a document by applying a number of various steps as disclosed in claim 20. Particularly, Motamed provisional does not disclose or suggest:

1. a storage medium for use in an electronic device;
2. entering of a total number of tabs
3. entering a location of each tab;
4. formatting the document; or
5. transmitting the document to a printing device.

It is therefore respectfully submitted that claim 20 distinguishes patentably and unobviously over Motamed provisional.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (**Claims 1-20**) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment B. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Marina Zalevsky, at Telephone Number (216) 861-5582.

Respectfully submitted,

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